

PATENT

Case Docket No. GNE.3030R1C10

Date: June 27, 2002

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Desnoyers et al.  
Appl. No. : 10/035,977  
Filed : December 26, 2001  
For : SECRETED AND  
TRANSMEMBRANE  
POLYPEPTIDES AND  
NUCLEIC ACIDS ENCODING  
THE SAME  
Examiner : Unknown

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June 27, 2002

(Date)

AnneMarie Kaiser, Reg. No. 37,649

TRANSMITTAL LETTER

United States Patent and Trademark Office  
P.O. Box 2327  
Arlington, VA 22202

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LICENSING & REVIEW

Dear Sir:

Enclosed for filing in the above-identified application is:

- (X) Request for Reconsideration and Withdrawal of Notice Requesting Property Rights Statement.
- (X) The Commissioner is hereby authorized to charge any additional fees which may be required, now or in the future, or credit any overpayment, to Account No. 11-1410.

AnneMarie Kaiser  
Registration No. 37,649  
Attorney of Record

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## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Desnoyers et al.  
App1. No. : 10/035,977  
Filed : December 26, 2001  
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NUCLEIC ACIDS ENCODING  
THE SAME  
Examiner : Unknown

## CERTIFICATE OF FAX TRANSMISSION

I hereby certify that this correspondence and all marked attachments are being facsimile transmitted to the Patent and Trademark Office on the date shown below:

June 27, 2002

(Date)

AnneMarie Kaiser, Reg. No. 37,649

**REQUEST FOR RECONSIDERATION AND WITHDRAWAL OF NOTICE**  
**REQUESTING PROPERTY RIGHTS STATEMENT**

Assistant Commissioner for Patents  
P.O. Box 2327  
Arlington, VA 22202

Attn: LICENSING AND REVIEW

Dear Sir:

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Applicants received a Notice mailed April 26, 2002, requesting a Department of Energy property rights statement under 42 U.S.C. § 2182. A copy of the Notice is attached.

The subject matter in the above-referenced application is not "useful in the production or utilization of special nuclear material or atomic energy." Instead, the subject matter of the above-referenced application relates to the identification and isolation of novel nucleic acids and to the recombinant production of novel polypeptides.

The subject matter in the above-referenced invention was not made or conceived in the course of, or in connection with, or under the terms of any contract, subcontract or arrangement entered into with or for the benefit of the United States Atomic Energy Commission or its successors: Energy Research and Development Administration or the Department of Energy.

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App1. No. : 10/035,977  
Filed : December 26, 2001

In addition, the invention was not made (conceived or first actually reduced to practice) under nor is there any relationship of the invention to the performance of any work under any contract of the National Aeronautics and Space Administration.

The inventors conceived this invention while employed by Genentech, Inc. The invention was made during working hours and with the use of facilities, equipment, materials, funds, information, and services of Genentech, Inc. The entire right, title, and interest in said invention is assigned to Genentech, Inc.

Applicants therefore request that the Notice and requirement for a property rights statement be reconsidered and withdrawn and that the application be passed to Group Art Unit 1646 for examination.

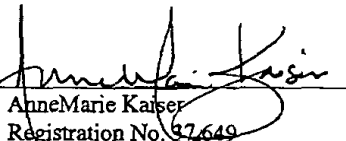
The undersigned attorney declares further that all statements made herein of her own knowledge are true and that all statements made on information and belief are believed to be true and further that these statements are made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issuing thereon.

Respectfully submitted,  
KNOBBE, MARTENS, OLSON & BEAR, LLP

Dated:

June 27, 2002

By:

  
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TO: United States Patent and Trademark Office  
ATTENTION: LICENSING AND REVIEW  
FACSIMILE NO.: 703-305-6384  
FROM: AnneMarie Kaiser, Reg. No. 37,649  
CLIENT CODE: GNE.3030R1C10  
APP. NO.: 10/035,977  
PAGES: 4 (INCLUDING THIS SHEET)

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**MAILED**

JUN 27 2002

**LICENSING & REVIEW**

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San Francisco CA 94111

In re Application of:  
Desnoyers et al:  
For Serial No. 10/035,977

DECISION ON  
REQUEST FOR  
RECONSIDERATION

Filed: December 26, 2001

For: **SECRETED AND TRANSMEMBRANE POLYPEPTIDES AND NUCLEIC  
ACIDS ENCODING THE SAME**

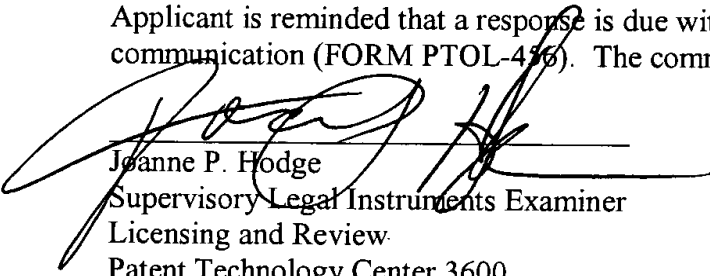
This is a decision on the REQUEST FOR RECONSIDERATION filed June 19, 2002 responding to the communication (FORM PTOL-456) mailed May 21, 2002.

The request has been **DENIED** to the extent indicated below.

42 U.S.C. 2182 states in part "... useful in the production **or utilization of special nuclear material or atomic energy**". A review of the application file history reveals among other things the use of a radioactive isotope "<sup>32</sup>P" as disclosed in at least page 119 of the instant specification. Therefore under the directions from the Department of Energy (DOE) this application has been made available to them under 42 U.S.C. 2182 since the following subject matter relates to at least one of the following:

- G. Materials, apparatus and methods concerning isotope and/or radioactive source technology including those utilizing (including responsive to) radioactive sources in:
  - a. Life Sciences such as medicine (diagnostic and therapeutic), ecology, disease and pest control, animal husbandry, etc.
  - b. Industrial processes such as food processing, sterilization, polymer production, etc.
  - c. Investigations of the environment or the earth
- H. Instruments employing a radioactive source and/or radioactivity detector in the operation thereof.

Applicant is reminded that a response is due within forty-five days of the mailing date of the communication (FORM PTOL-456). The communication having been mailed May 21, 2002.

  
Joanne P. Hodge  
Supervisory Legal Instruments Examiner  
Licensing and Review  
Patent Technology Center 3600